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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.        |
|---|-------------|----------------------|---------------------|-------------------------|
| 10/824,067  | 04/14/2004  | Andrew Carl Root     | ENL-275-B           | 6071                    |
| 22825   | 7590        | 08/19/2004           | EXAMINER            |                         |
| WILLIAM M HANLON, JR<br>YOUNG & BASILE, PC<br>3001 WEST BIG BEAVER ROAD<br>SUITE 624<br>TROY, MI 48084-3107 |             |                      |                     | COURSON, TANIA C        |
| ART UNIT  |             | PAPER NUMBER         |                     |                         |
| 2859  |             |                      |                     | DATE MAILED: 08/19/2004 |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                              |                     |  |
|------------------------------|------------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>       | <b>Applicant(s)</b> |  |
|                              | 10/824,067                   | ROOT, ANDREW CARL   |  |
|                              | Examiner<br>Tania C. Courson | Art Unit<br>2859    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-18 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 14 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. 09/918,582.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-6, 11-12, 14-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,782,630 (Root). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-6, 11-12, 14-16 of the current application are broader claims than claims 1-10 of U.S. Patent 6,782,630 (Root) by

deleting the intended use portion of applying and setting of molding material to at least the sole of the foot.

3. Claims 7-10 and 17-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim1 of U.S. Patent No. 6,782,630 (Root) in view of U.S. Patent No. 5,361,133 (Brown et al.). The limitations as stated in claims 7-10 and 17-18 of this application are already indicated in the combination of claim 1 of U.S. Patent No. 6,782,630 (Root) in view of U.S. Patent No. 5,361,133 (Brown et al.).

Root '630 discloses a foot device and associated method including the following:

- a) a member having a planar surface on one side (Fig. 1, planar surface 21), operating means provided on the opposite side of the said member to said planar surface (Fig. 1, handle 28), said operating means further providing means for inverting and everting the planar surface of the member while the planar surface is in contact with the at least portion of the sole (Fig. 1);
- b) wherein said member carries means for measuring and indicating an angle of tilt of the planar surface (Fig. 1, unit 30);
- c) a leg rest (Fig. 1, leg rest 10), said member being movably mounted from the leg rest (Fig. 1, hinged connection 15);
- d) wherein said member is pivotally mounted from the leg rest for angular movement about a substantially vertical axis (Fig. 2);

- e) wherein means is provided for measuring and indicating the angle of angular movement of said member and its planar surface about the substantially vertical axis (Fig. 2).

Root '630 does not disclose wherein means for measuring and indicating the angle of angular movement are electronic, comprise a potentiometer and comprise a Vernier scale arrangement, wherein means are provided for setting a datum, further comprising the step of measuring the angle of tilt of the planar surface and further comprising monitoring the point at which the head of the metatarsal in contact with the planar surface lifts away from the planar surface.

Brown et al. teach a method and apparatus for analyzing feet that consists of wherein means for measuring and indicating the angle of angular movement are electronic (Fig. 2, controller 200), comprise a potentiometer (Fig. 1, assemblies 43 and 74) and comprise a Vernier scale arrangement (Fig. 1, assemblies 43 and 74), wherein means are provided for setting a datum (Fig. 1), further comprising the step of measuring the angle of tilt of the planar surface (Fig. 1) and further comprising monitoring the point at which the head of the metatarsal in contact with the planar surface lifts away from the planar surface (Fig. 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the foot device and associated method of Root '630, so as to include an electronic means, a potentiometer, a Vernier scale arrangement, setting a datum and means for measuring and monitoring, as

taught by Brown et al., so as to provide a means for increasing the accuracy in measuring angular movement during use of the device.

4. Claim 13 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,782,630 (Root) in view of U.S. Patent No. 4,323,080 (Melhart). The limitations as stated in claim 13 of this application are already indicated in the combination of claim 1 of U.S. Patent No. 6,782,630 (Root) in view of U.S. Patent No. 4,323,080 (Melhart).

Root '630 discloses a foot device and associated method including the following:

- a) a member having a planar surface on one side (Fig. 1, planar surface 21), operating means provided on the opposite side of the said member to said planar surface (Fig. 1, handle 28), said operating means further providing means for inverting and everting the planar surface of the member while the planar surface is in contact with the at least portion of the sole (Fig. 1);
- b) means for indicating pressure of application of the said member (Fig. 1, unit 30).

Root '630 does not disclose wherein means for measuring and indicating the pressure of application of the said member comprises a strain gauge arrangement.

Melhart teaches a method and apparatus for measuring the feet that consists of wherein means for measuring and indicating the pressure of application of the said member comprises a strain gauge arrangement (Fig. 3, digital voltmeter 107). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the foot device and associated method of Root '630, so as to include a strain gauge, as taught by Melhart, so as to provide a means for providing additional measurements during use of the device.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited on PTO-892 and not mentioned above disclose a device for a foot:

Tatum et al. (US 5,908,397)

Fullen et al. (US 5,678,448)

Guhl (US 5,063,918)

Scott (US 4,886,258)

Donnery (US 4,771,548)

Sugarman et al. (US 4,443,005)

Stryker (US 3,143,110)

Stevens (US 3,020,909)

Scheidl (US 743,663)

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (571) 272-2239. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (571) 272-2245.

The fax number for this Organization where this application or proceeding is assigned is (703) 872-9306.



DIEGO F.F. GUTIERREZ  
SUPERVISORY PATENT EXAMINER  
GROUP ART UNIT 2859

TCC  
August 18, 2004

CHRISTOPHER W. FULTON  
PRIMARY EXAMINER